

REMARKS

Claims 1-14 remain in the application. Only claims 1 and 8 are in independent form and have been amended to further clarify the invention and distinguish over the prior art. Support for these amendments is found on page 6, lines 28-29. These amendments have not made the claims broader in scope and therefore, no further searching is required.

Claims 1-3 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Graham (U.S. Patent No. 6,631,372) in view of De Souza, et al. (U.S. Application No. 2002/0099611). We respectfully submit that De Souza, et al., which was published on July 25, 2002, is not prior art and was not publicly available at the U.S. priority date of June 15, 2000 of the present invention. Accordingly, Graham and De Souza, et al. could not have been combined at the time the present invention was made. Reconsideration of the rejection based on 35 U.S.C. §103(a) is respectfully requested.

Applicant respectfully submits that the presently claimed invention is in fact patentable and note that in the case of *Hodosh v. Block Drug Co. Inc.*, 786 F. 2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed Cir. 1986) it was held that the following rules should apply to obviousness rejections (from MPEP 2141):

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention; at least one of the references

must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103."

This doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281, 297, 227 U.S.P.Q. 657, 667. The District Court concluded:

"Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art which would have made such a combination appropriate."

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

The Office Action holds that Graham discloses a method and business application for facilitating the exchange of information between vendors and seekers with the steps of: entering vendors' item records as listings in an electronically searchable data structure on the basis of seeker queries generated

by seekers. The Office Action further holds that Graham discloses ensuring that the vendor's item records are for items appearing in an electronically searchable item catalog, ensuring that seeker queries are in respect of items appearing in the item catalog. The Office Action states that Graham fails to disclose making available the identity of the seeker for viewing by the vendors corresponding to matched listings before making available the identity of the vendors for viewing by the seeker.

Also, the Office Action holds that De Souza, et al. discloses the concept of creating a custom enterprise site having a subset of buyers and/or sellers from a set of buyers/sellers participating on the extranet-based e-commerce platform. De Souza, et al. further discloses the concept of having authorized individual form a first EBEP vendor sending contact to an EBEP buyer (step 1645). When the authorized individual from the EBEP buyer enterprise selects "view contracts and orders" from a menu in the purchasing transaction area in the EBEP buyer's enterprise site (step 1655), the contract created above appears on a listing of contracts and orders. The authorized individual from the EBEP buyer can select the contract created above from the listing (step 1660).

Therefore, the Office Action holds that it would have been obvious to modify the search engine of Graham to include the EBEP vendor selecting authorized individual from the EBEP buyer for a sales proposal before the EBEP buyer selects a sales proposal from a first EBEP vendor from the list of sales proposals in order to provide sensible information that can only be accessible to a particular client's business partners.

Not only does Graham fail to disclose a critical element of the invention, but there is no suggestion in Graham to address the problem of the present invention of facilitating the sale of high value goods online where vendors are reluctant to allow perusal of commercially sensitive information, e.g. that they have particular products for sale, to anonymous seekers.

The Graham citation relates to search engines used to locate goods and services on the Internet (Col 1 lines 13-15). It addresses the problem of ranking webpages that refer to goods in order to maximize sales of the goods (Col 2 lines 4-10). Figure 2 of Graham depicts a typical search sequence according to one aspect of the Graham invention. The Graham system allows clients, i.e. "seekers," to search for an item (goods and services) on the Internet, a hit list is generated of relevant merchant, i.e. "vendor," websites from which the client can select a hit, the browser navigates to the selected merchant's website at which point the client is made aware of the merchant's identity, and while at the merchant's website, the client can do many things such as "looking around the site at the merchant's offerings, purchasing goods or services, or declining to make a purchase" (col. 3 line 44 – col. 4 line 18).

The merchant's identification is not hidden from the client at any time except prior to the initiation of a search. Furthermore, if the client does engage in a transaction then the client's identity will become known to the merchant but this is after, not before, the merchant's identity became known to the client and is the converse of the present invention. The Graham patent does not contemplate the problem of accessing information about high value products that vendors are reluctant to make available on their websites. The Graham patent does not identify the problem that vendors of some high value goods do not wish to have listings of their inventories made available unless they first know the identity of the potential purchaser. Only with a secure environment where the client can be positively identified as someone with whom the merchant wants to deal, will such a high value product merchant be willing to disclose sensitive information that could fall into competitors' hands.

Applicant concurs with the Office Action that "Graham however fails to explicitly disclose making available the identify of the seeker for viewing by the

vendors corresponding to matched listings before making available the identity of the vendors for viewing by the seeker."

In contradistinction to Graham, as stated at paragraph [0008] of the publication of the present application (2001/0054015), the present invention provides a method for facilitating the electronic exchange of information between vendors and seekers, (e.g. potential purchasers of items) who may be unknown to each other, where the vendor is prepared to make commercially sensitive information, e.g. listings of a vendor's items, available to the seeker provided that the seeker's identity is made available to the vendor before making the listings available. In an embodiment of the invention claimed in claim 4, a vendor is able to blacklist seekers who are not to be granted access to the vendor's records.

The present inventor conceived of the invention because he was faced with the problem of vendors of high value products, e.g. earth moving machinery, being reluctant to make details of their inventories available online. As a result, the inventor realized that there would be a barrier to the success of an online business that he contemplated for facilitating the commercial transaction of earth moving machinery. After investigation, the inventor discovered that the vendors' reluctance to enter into online transactions was because they did not wish to have their inventories scrutinized unless the identity of potential purchasers, i.e. "seekers" would first be made available to them.

The invention, as claimed in independent claims 1 and 8 of the presently pending application provides an extremely elegant solution to the problem because it provides that the identity of the seekers (e.g. potential purchasers) be made available to the vendors before the vendors' identities are associated with listings of their inventories for review by the seekers. Consequently, the fact that a particular vendor has a particular item in inventory cannot be gleaned by the seeker unless the seeker's identity is first made available for viewing by the vendor.

Since Graham does not address the same problem, or a related one, to that addressed by the present invention, and since Graham does not teach the solution of the present invention, but rather teaches the converse, we submit that a hypothetical worker would not look to Graham in order to arrive at the solution of the present invention.

As stated above, the De Souza, et al. patent is not a valid prior art reference. Notwithstanding, Applicant submits that the combination of De Souza, et al. with Graham is not permissible as it does not meet the requirements set out in the *Hodosh v. Block Drug Co. Inc.* case described above. Furthermore, even if De Souza, et al. is combined with Graham, the presently claimed invention would not be arrived at because, as explained below, De Souza, et al., like Graham, does not in fact disclose the essential feature of making available the identity of the seeker to the vendors before making available the identity of the vendors to the seeker.

At paragraph [0005] of De Souza, et al., Internet based, e-commerce systems are discussed and at paragraph [0006] it is explained that four problems are associated with such systems as follows:

- i) Business content on the host server must generally be manually input.
- ii) Updates to the business content on the host server are generally controlled by the hosting entity, and not the business entity.
- iii) While some automation of the business entity's sales transactions is typical, automation of purchase transactions is not available.
- iv) Many facets of a normal business relationship must be conducted offline.

It will be noted that De Souza, et al. does not discuss the problem addressed by the present applicant and does not disclose the reason for the problem. That is, De Souza, et al. does not explain that vendors of high value

goods may be reluctant to use online transaction portals because they do not wish to have their inventories available for perusal by anonymous, and possibly competing, parties.

Figure 14 of De Souza, et al. referred to by the Office Action, comprises a flowchart showing the steps by which a buyer, i.e. "seeker", creates a contract with a vendor for a purchasing transaction. However, prior to creating the contract, the buyer must first create a request for quotation (RFQ) in accordance with the method shown in Figure 12. This is clearly explained at paragraph [0087] of De Souza, et al. where it is stated that "...an EBEP buyer for that transaction (i.e., the EBEP user who created the RFQ for the particular transaction) can create a contract with an EBEP vendor for that transaction (i.e. any of those EBEP users who have responded to the RFQ with a sales proposal)."

Referring to Figure 12 of De Souza, et al., "the EBEP user who created the RFQ for the particular transaction" did so earlier by selecting the particular vendors at step 1340. This is done prior to sending an RFQ to the vendors at step 1380 at which time the vendor is made aware of the buyer's identity. That is, the identity of the seeker is made available for viewing by the vendors after making available the identity of the vendors for viewing by the seeker. This is the converse of the teaching of the present invention.

Applicant respectfully submits that De Souza, et al. teaches away from the claimed invention because, as explained above, it clearly teaches making the identity of the seeker available to the vendors after, not before, making the identity of the vendors available to the seeker. Furthermore, because De Souza, et al. does not address the problem addressed by the present invention, a skilled addressee faced with the same problem as the present inventor, at the priority date, would not have viewed combining De Souza, et al. with Graham as being reasonably expected to succeed in overcoming the problem. Because neither

De Souza, et al. nor Graham discuss or address the problem addressed by the present inventor, it is not clear why a skilled addressee would have combined them without the impermissible use of hindsight.

Therefore, since neither of the combined references alone or in combination suggest the currently claimed invention, it is consequently respectfully submitted that the claims are clearly patentable over the combination, even if the combination were to be applied in opposition to applicable law, and reconsideration of the rejection is respectfully requested.

Claims 4-7 and 11-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Graham patent in view of De Souza, et al. as applied to claims 1 and 8 above, and further in view of Gardner, et al. (U.S. Patent No. 5,758,327). As stated above, the De Souza application is not a valid prior art reference. Reconsideration of the rejection based on 35 U.S.C. §103(a) is respectfully requested.

The Office Action states that Gardner, et al. discloses the concept of processing electronic requisition with the step of providing for each vendor to nominate seekers who are not to be granted access to the vendor's records (via private catalog function and to control access to and downloading of supplier-maintained catalog data). Gardner, et al. further discloses making available companies and vendor's contact details (via an authorization process). Gardner, et al. further discloses the concept of having catalog requisitions (in which specific vendors are assigned to particular companies), and non-catalog requisitions (which require involvement by a buyer who locates a vendor list of items). The Office Action holds that it would have been obvious to modify the exchange of information of Graham and De Souza to include the electronic requisition processing with company-specific rules as taught by Gardner, et al. in order to facilitate electronic commerce for a number of companies.

As previously stated above, De Souza, et al. is not a valid prior art reference. Notwithstanding, as stated above, Graham and De Souza, et al., alone or in combination, neither disclose nor suggest the required element of the present invention of the seeker's identity being available to the vendor before the vendor's identity is available to the seeker. Claims 4-7 and 11-14 are respectively ultimately dependent upon claim 1 and claim 8 which Applicant submits are herein demonstrated to be both novel and non-obvious. Accordingly, Applicant respectfully submits that claims 4-7 and 11-14 are both novel and non-obvious by virtue of their claim dependencies.

Therefore, since neither of the combined references alone or in combination suggest the currently claimed invention, it is consequently respectfully submitted that the claims are clearly patentable over the combination, even if the combination were to be applied in opposition to applicable law, and reconsideration of the rejection is respectfully requested.

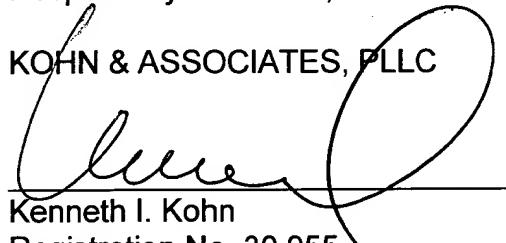
The present amendment adds no new matter and the claim and amendments are supported by the specification. It is respectfully submitted that the present application is now in condition for allowance, which allowance is respectfully requested.

USSN: 09/881,991
Attorney Docket No: 3133.00003

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC

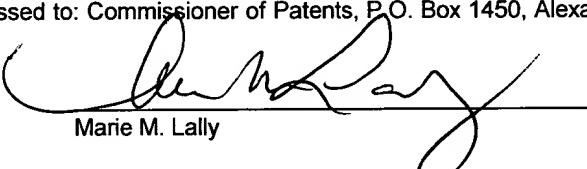

Kenneth I. Kohn
Registration No. 30,955
30500 Northwestern Hwy., Ste 410
Farmington Hills, Michigan 48334
(248) 539-5050

Dated: November 28, 2005

CERTIFICATE OF MAILING

Express Mail Mailing Label No: EV 723 402 562 US
Date of Deposit: November 28, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313, MAIL STOP RCE.


Marie M. Lally